

35 U.S.C. § 103(a) Rejection - Claims 1-5:

Claims 1-5 continue to stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously applied U.S. Patent No. 6,218,930 to Katzenberg et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

In reviewing the Examiner's rejection and response to Applicant's arguments, Applicant submits that the Examiner is ignoring the fact that Katzenberg fails to disclose having any identifier circuit in the access node 64. Specifically, in rejecting the claims, the Examiner has argued that a sensing potential is applied to the access equipment 10 (*see* col. 2, lines 55-56) which is composed of the access node 64 and the terminal 62. Further, the "identifier circuit," upon which the Examiner is relying, is constituted by a DC-DC converter (*see* col. 3, lines 12-18). However, Katzenberg fails to identify or mention whether the DC-DC converter is in the access node 64 or in the terminal 62. Therefore, there is no disclosure of a "terminal adapter" which contains the identifier circuit of the present invention.

Specifically, contrary to the present invention, Applicant submits that the DC-DC converter (which the Examiner relies on as being the identifier circuit of the present invention) is located within the terminal 62 and not the access node 64, as would be the case in the present invention.

First, Applicant notes that it is well known that known IP phone terminal contain a DC-DC converter for converting 48V supplied by the network into lower voltages used by the electronic circuits of the terminal. Because of this, there is no need for Katzenberg, or any other skilled artisan, to add another DC-DC converter to the access node 64.

Secondly, Figure 3, of Katzenberg, shows that the access node supplies “Data + phantom power” to the terminal 62. This indicates that the power is supplied to the terminal via a phantom circuit in the same way as it is carried by the premises wiring 66. Stated differently, the power is supplied without any kind of conversion.

In view of the foregoing discussion, the access node 64, of Katzenberg, is merely a mechanical interface (i.e. a wall plug), which is used to plug the terminal 62 to the fixed premises wiring 66. There is no disclosure, teaching or suggestion of the access node 64 containing any DC-DC converter, or any other type of circuit, which could be considered to correspond to the identifier circuit of the present invention.

In view of the foregoing, Katzenberg does not disclose a “terminal adapter” as claimed. It is worth noting that the claims are directed to a “terminal adapter,” and not a network or similar configuration. Thus, components or circuits which are found in Katzenberg outside of the access node 64, should not be considered, as these components are not part of a “terminal adapter. Accordingly, Applicant submits that Katzenberg fails to teach or suggest each and every feature of the claimed invention.

Additionally and independently, Applicant submits that the Examiner’s rejection fails to properly set forth an argument that Katzenberg teaches each and every limitation of the claimed invention. Specifically, in continuing to reject the claims, the Examiner makes the following statement:

Furthermore, the identifier circuit used by Katzenberg is passive, since the circuit merely has to determine if a particular voltage level is detected, in order to determine if the equipment can support remote power feed (col. 3, lines 4-11), terminals being

identified as being able to support remote power feed or not.
(Office Action, page 2-3).

In making the above statement, it appears that the Examiner is saying that Katzenberg “inherently” discloses that the identifier circuit is “passive.” Stated differently, the Examiner is essentially saying that the identifier circuit in Katzenberg “must” be passive. The Examiner does not assert that this would have been obvious to a skilled artisan, but instead argues as if it must be the case. Applicant disagrees.

Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan

Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference). Thus, even if it were assumed in this case that the identifier circuit in Katzenberg could only be a passive or active circuit, such a disclosure is insufficient to meet the high burden of anticipation, because neither of which is “necessarily present” in Katzenberg.

Therefore, again, the Examiner’s analysis fails.

In view of the foregoing, Katzenberg fails to teach or suggest each and every feature of the present invention. Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as required under the provisions of 35 U.S.C. § 103(a).

Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of claim 1. Further, as claims 2-5 depend on claim 1, Applicant submits that these claims are also allowable, at least by reason of their dependence.

Request for Interview:

In view of the foregoing, Applicant submits that the present application is in condition for allowance. However, if the Examiner continues to reject the pending claims, Applicant hereby requests an interview with the Examiner so as to advance the prosecution of the present application.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

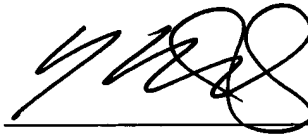
RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/995,721

Our Ref.: Q67037
Art Unit: 2636

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Terrance J. Wikberg
Registration No. 47,177

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 26, 2005